

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JANET SCHWARTZ

Appeal No. 2000-0602¹
Reexamination Application No. 90/004,933

ON BRIEF

Before JOHN D. SMITH, *Administrative Patent Judge*, McKELVEY, *Senior Administrative Patent Judge*, and TIMM, *Administrative Patent Judge*.

TIMM, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

This appeal was taken under 35 U.S.C. § 134 from an examiner's final rejection of claims 1-9, 16, 17, 24 and 25, which are all of the claims pending in this Reexamination proceeding 90/004,933.

¹Reexamination proceeding for U.S. Patent 5,312,633, issued May 17, 1994 which is based on Application 08/013910, filed February 5, 1993, which is said to be a continuation-in-part of Application 07/505,798, filed April 6, 1990.

Appellant has withdrawn claims 1-9, 16 and 17 from appeal (Brief, page 2). Therefore, the appeal is limited to claims 24 and 25. Because the issues have not been sufficiently developed, we remand.

DISCUSSION

Claim 24 relates to a method of making a soft pretzel and claim 25 relates to a baked stuffed soft pretzel food product. Claim 24 is dependent on claim 1. In the method of claim 1, a soft pretzel dough product is formed in which edible filling is “substantially enclosed” by soft pretzel dough and baked. Claim 24 adds a step of dipping the pretzel dough product in a caustic soda solution prior to baking. Claim 25 is directed to a baked stuffed soft pretzel having a brown color as a result of a caustic soda solution dip prior to baking, the soft pretzel portion “completely enclosing” edible filling material.

Claim 24 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,803,084, issued February 7, 1989 to Shine. Claim 25 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Shine. Both claims 24 and 25 also stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of a newspaper article by Gail Perrin², a Product Alert from an Information Access Co. newsletter³ and U.S. Patent 4,759,939, issued July 26, 1988 to Keller.

²Gail Perrin, *Frozen Food Goes Upscale*, Boston Globe, Oct. 28, 1987, at 46, *available at* DIALOG, File No. 631.

³*Stuffin’ Pretzels with Spinach N’ Cheese Filling*, 18 Information Access Co. Product Alert, Nov. 14, 1988, DIALOG, File No. 636.

Scope and Meaning of Substantially Enclosed

Before one can evaluate whether the prior art renders the claimed subject matter unpatentable, the scope of the claim must be ascertained. Claims undergoing reexamination are given their broadest reasonable interpretation. *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5-6 (Fed. Cir.), *cert. denied*, 474 U.S. 828 (1985). What is key here is that the interpretation must be reasonable. *See In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000)(“The specification, although lengthy, contains no definition of ‘shared’ or ‘sharing’ that would require the Board to construe those limitations in the narrower manner asserted by Mr. Hyatt. The Board's interpretation of those terms, although broad, is not unreasonable.”). Here, the Examiner has put forth a very broad interpretation of “substantially enclosed” while the Appellant has argued an extremely narrow interpretation. Neither party has presented us with sufficient credible evidence upon which we may make a reasonable interpretation of “substantially enclosed.” Furthermore, we are unsure as to whether the Examiner has adequately considered an issue of claim definiteness under 35 U.S.C. § 112, second paragraph.

The Examiner here has construed “substantially enclosed” to encompass any enclosing simply because there is no definition of “substantially enclosed” in the claims (Answer, pages 3 and 4). It is not clear upon the current record whether the Examiner made any review of the Specification to

attempt to divine the meaning of “substantially enclosed”. Such a review is required as it would be unreasonable to ignore any interpretive guidance afforded by the Specification. *See In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). The Examiner has pointed to no description within the Specification which indicates that “any enclosing” by the dough can be reasonably interpreted as “substantial enclosing.” While the modifier “substantially” certainly does broaden the term “enclosed” to some degree, it “cannot be allowed to negate the meaning of the word it modifies.” *In re Hauserman, Inc.*, 892 F.2d 1049, 15 USPQ2d 1157, 1158 (Fed. Cir. 1989)(quoting *Arvin Industries, Inc. v. Berns Air King Corp.*, 525 F.2d 182, 185, 188 USPQ 49, 51 (7th Cir. 1975) and citing *Borg-Warner Corp. v. Paragon Gear Works, Inc.*, 355 F.2d 400, 404, 148 USPQ 1, 4 (1st Cir. 1965), *cert. dismissed*, 384 U.S. 935, 149 USPQ 905 (1966)). The phrase “substantially enclosed” would seem to allow a reasonable deviation from “enclosed”, but “substantially enclosed” is not expansive enough to encompass any and all wrapping of dough around the filling.

The Appellant, on the other hand, urges a narrow meaning which equates “substantially enclosed” with “completely enclosed”. This interpretation would appear to be unreasonably narrow. Words such as “substantially”, “approximately”, and “about” are broadening terms. Words such as “completely”, “entirely”, “totally” are more confining. If something is “completely enclosed” it probably cannot have any openings. If something is “substantially enclosed” openings may be present. Appellant implores us to interpret the claim in light of column 4, lines 12-16 of the Specification (Brief, page 8).

However, column 4, lines 12-16 fails to set forth the definition sought by the Appellant. This portion of the description does not use or define the phrase “substantially enclosed”. Instead this portion of the description discloses that it is vital to completely seal the filling within the dough to create a closed environment to prevent caustic soda solution from entering into the pretzel interior. However caustic dipping is not required in every embodiment described in the Specification and perfect closure of the dough is not always necessary. For instance, the dough may be filled by inserting a conventional filling nozzle 78, shown in Fig. 12. Crimping or pressing the ends of the dough piece is required if caustic dipping is carried out but otherwise not necessary. Therefore, if there is no caustic dipping step, the dough may retain some openings. See column 6, lines 9-24. Therefore, it would appear that it is not reasonable to equate complete enclosure with substantial enclosure as recited in claim 1.

We note that it is the Applicants' burden to precisely define the invention. See 35 U.S.C. § 112, second paragraph (“The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”). This section puts the burden of precise claim drafting squarely on the Applicant. *See In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). If a claim is unreasonably imprecise, the Examiner should reject the claim under 35 U.S.C. § 112, second paragraph as indefinite. We will not endeavor to decide whether or not a rejection under 35 U.S.C. § 112, second paragraph is justified in this case. By statute, the function of the Board is to review the adverse decisions of examiners, not

perform an examination in the first instance. 35 U.S.C. § 7(b). Nonetheless, we point out that a reading of the Specification as a whole indicates that “substantially enclosed” would seem to encompass at least small openings in the dough. However, there is no indication how big the openings must be before the filling is no longer “substantially enclosed” in the dough. We suggest that the Examiner carefully review the issue and make a determination with regard to the definiteness of claim 1 and claim 24 which depends thereon.

Anticipation of Claim 24 by Shine

Once the scope and meaning of the claims has been ascertained, the construed claims must be compared to the prior art to determine whether the claims are anticipated or rendered obvious by the prior art. “To be anticipating, a prior art reference must disclose each and every limitation of the claimed invention, must be enabling, and must describe the claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention.” *Helifix Ltd. v. Blok-Lok Ltd.*, 208 F.3d 1339, 1346, 54 USPQ2d 1299, 1303 (Fed. Cir. 2000).

The Examiner has rejected claim 24 as anticipated by Shine. Shine describes preparing soft pretzel dough and filling the dough with a filling composition (Col. 5, lines 12-17 and Example 2). Shine, however, does not expressly state that the filling composition is “substantially enclosed by the dough” as recited in claim 24. The Examiner states that “it is inherent that the filling is enclosed by the dough or else the filling will leak out from the dough (Answer, page 3). Appellant responds by pointing

out that Shine does not define “filled” or “filling”(Brief, pages 6 and 7). Both the Examiner and Appellant have missed the key issue here. The question is not one of inherency⁴ and the fact that Shine does not define “filled” does not end the inquiry. The real issue is: What does “filled with ... filling” mean to one skilled in the art of pretzel making? On this point the Examiner offers little evidence or analysis; simply saying that one of ordinary skill in the art would know what “filled” means⁵ (Answer, page 9). Appellant merely presents an argument of counsel, which is not evidence⁶, that a danish roll having exposed fruit and syrup is regarded as “filled”⁷(Brief, page 9). These statements tell us little about what a pretzel maker of ordinary skill would regard as soft pretzel dough “filled with ... filling” as these words are used in Shine. The Examiner is asked to clarify the anticipation rejection with regard to what one of ordinary skill in the art of pretzel making would understand “filled with ... filling” to mean.

⁴“Inherency ... may not be established by probabilities of possibilities. The mere fact that a certain thing *may result* from a given set of circumstances is not sufficient.” *Mehl/Biophile Int’l Corp. v. Milgram*, 192 F.3d 1362, 1366, 52 USPQ2d 1303, 1307 (Fed. Cir. 1999)(quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)). *See also Glaxo, Inc. v. Novopharm Ltd.*, 830 F.Supp. 871, 29 USPQ2d 1126 (E.D. N.C. 1993), *aff’d*, 34 USPQ2d 1565 (Fed. Cir.), *cert. denied*, 516 U.S. 988 (1995)(“[I]t is not sufficient that a person following the disclosure sometimes obtain the result set forth in the claim, it must invariably happen.”)

⁵We note that the Examiner’s comment was made in reference to the obviousness of claim 25 in view of Shine and not in connection with the issue of anticipation of claim 24. The Examiner may wish to enhance the record with respect to the anticipation rejection.

⁶*Estee Lauder, Inc. v. L’Oreal, S.A.*, 129 F.3d 588, 592, 44 USPQ2d 1610, 1615 (Fed. Cir. 1997)(argument of counsel does not take the place of evidence).

⁷This argument was made in reference to the rejection of claim 25 as obvious over Shine.

Both the Examiner and Appellant are invited to add evidence, such as publications, patents and declarations, regarding the meaning to one of ordinary skill in the art. Note that extrinsic evidence can be used to explain, but not expand, the meaning of the reference when determining what an anticipatory reference describes to one of ordinary skill in the art. *In re Baxter Travenol Labs.*, 952 F.2d 388, 392, 21 USPQ2d 1281, 1284 (Fed. Cir. 1991).

We also note that Appellant has argued that Shine fails to provide an enabling disclosure (Brief, pages 7-8). Appellant bears the burden of introducing evidence that Shine lacks an enabling disclosure. *In re Fracalossi*, 681 F.2d 792, 793, 215 USPQ 569, 570 (CCPA 1982). Appellant has provided no evidence that the process described in Example 2 of Shine will not work as intended. Appellant may wish to provide such evidence if available.

Obviousness of Claim 25 over Shine

“A claimed invention is unpatentable as obvious ‘if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *In re Gartside*, 203 F.3d 1305, 1319, 53 USPQ2d 1769, 1778 (Fed. Cir. 2000)(quoting 35 U.S.C. § 103(a) (1994)).

The Examiner states that it would have been obvious to use any kind of commercially available flour but does not affirmatively indicate that spring flour was commercially available at the time of

invention nor that spring flour was conventionally used in baking. The Examiner may wish to add a finding that spring flour was a well known baking ingredient or, preferably, add evidence, such as prior art, to the rejection showing the use of spring flour in baking items such a pretzels was conventional at the time of invention.

We also note that the reasons presented for rejection of claim 25 as unpatentable based on obviousness may also apply to claim 24. The Examiner may wish to consider rejecting claim 24 as obvious over Shine as well as claim 25. We express no opinion at this time as to whether a *prima facie* case of obviousness in fact exists.

Summary

The Examiner has not presented a rejection susceptible to meaningful review. It is the Examiner's initial burden to establish reasons of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). However, we think reversal of the Examiner's decision to reject claims 24 and 25 would be premature. The facts have been insufficiently developed with respect to key issues. In such circumstances, we must remand to the primary fact finder, the Examiner, for further development of the record. It is important that ambiguous or obscure bases for decision do not stand as barriers to a determination patentability.

In summary:

1. The Examiner may wish to review whether the phrase “substantially enclosed” as used in claim 24 is definite.

If the term is vague or indefinite, a rejection under 35 U.S.C. § 112, second paragraph should be made and a reasonable effort should be made to construe the term for purposes of rejection over prior art.

2. Both the Examiner and Appellant may wish to place evidence and argument into the record concerning the scope of “substantially enclosed” as used in claim 24.

3. Examiner and Appellant may wish to place evidence and argument into the record which would shed light on the meaning of “filled”, as used in Example 2 of Shine, to one of ordinary skill in the pretzel art.

4. Appellant may wish to place evidence into the record showing that Shine is not enabled.

5. Examiner may wish to place evidence into the record showing that spring flour was a well known baking ingredient at the time of invention.

6. Examiner may wish to place evidence into the record tending to show that those of ordinary skill in the art conventionally completely enclosed edible filling materials into dough products to be baked to prevent leakage.

7. The Examiner may wish to consider rejecting claim 24 as unpatentable under 35 U.S.C. § 103, as well as anticipated under 35 U.S.C. § 102 over Shine.

CONCLUSION

For the reasons given, the application is remanded to the Examiner for further action not inconsistent with the views expressed in this opinion.

All reexamination proceedings must be carried out with special dispatch. 35 U.S.C. § 305; *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1156 (Fed. Cir. 1988). Therefore,

this application requires immediate action. The Examiner may wish to set a time for patent owner to submit any evidence and argument.

REMANDED

JOHN D. SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
FRED E. McKELVEY)	APPEALS
Senior Administrative Patent Judge)	AND
)	INTERFERENCES
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APPEAL NO. 2000-0602 - JUDGE TIMM
APPLICATION NO. 90/004,933

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DECISION: **AFFIRMED**

Prepared By: Leticia Pihulic

DRAFT TYPED: 05 Mar 01

FINAL TYPED: